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APR 26 2010

OFFICE OF PETITIONS

In re Application of :
Pat Yananton : LETTER REGARDING PATENT
Application No. 10/033,862 : TERM ADJUSTMENT
Filed: December 20, 2001 :
Attorney Docket No. 1718

This is a decision on the "Request for Reconsideration of the Patent Term Adjustment Determination," filed July 1, 2009, which is properly treated as a petition under 37 CFR 1.705(b). Applicants request that the initial Determination of Patent Term Adjustment under 35 U.S.C. 154(b) be corrected from forty (40) days to at least six hundred and fifty-eight (658) days.

The application for patent term adjustment is **GRANTED TO THE EXTENT INDICATED HEREIN.**

The Office has updated the PALM and PAIR screens to reflect that the patent term adjustment determination at the time of the mailing of the notice of allowance is **two hundred and nine (209) days** (775 days of Office delay - 566 days of applicant delay). A copy of the updated PAIR screen, showing the corrected determination, is enclosed.

On June 25, 2009, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 40 days. Applicants timely filed the instant application for patent term adjustment.¹ Specifically, applicants state:

In reviewing the patent term adjustment history, the applicant was charged with the following delays

¹ PALM finance records indicate the issue fee was paid on July 1, 2009.

- 181 days from the date of response to the non-final rejection of 07/16/2004. This response was filed 10/15/2004. In response to an examiner interview of 03/28/2005, a supplemental response was filed 16 days later. Applicant fails to see how 181 days of delay can be attributed to his actions as a result of this timeline.
- 146 days of added delay were added from 01/17/2006 after the response to nonfinal action was forwarded to the examiner. Applicant fails to see how 146 days of delay can be attributed to his action as a result of this timeline.
- 291 days were additionally added during a period from 01/31/2007 through 08/16/2007 in which a notice of allowance was issued and subsequently rescinded. Applicant fails to see how he could have done anything to affect this delay whatsoever.

Excerpt taken from "Request for Reconsideration of the Patent Term Adjustment Determination," filed July 1, 2009, page 2.

Applicants' contention is well taken relative to the reduction of the patent term adjustment of 181 days. The record supports a conclusion that the supplemental reply filed April 14, 2005, was expressly requested by the examiner within the meaning of 37 CFR 1.704(c)(8)². Accordingly, the reduction of 181 days is not warranted and is being removed.

² Pursuant to 37 CFR 1.704(c)(8),

(c) Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:

(8) Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date the supplemental reply or other such paper was filed.

Applicants' argument relative to the reductions of 146 days and 291 days has been considered and is not persuasive. A review of the application file record reveals that on July 15, 2005, a non-final Office action was mailed to which applicants filed a response on January 17, 2006. On June 8, 2006, and June 12, 2006, applicants filed supplemental responses to the non-final Office action. There is no evidence that the examiner requested that the supplemental amendments be filed. Pursuant to 37 CFR 1.704(c)(8), it is appropriate to enter a reduction to the patent term adjustment of 146 days beginning from the day after the date the initial reply was filed, January 18, 2006, and ending on the date the second supplemental reply was filed June 12, 2006³. Accordingly, the period of reduction to the patent term adjustment of 146 days for applicant delay pursuant to 37 CFR 1.704(c)(8) will not be removed.

Likewise, a review of the application file record reveals that on September 7, 2006, a non-final Office action was mailed to which applicants filed a response on January 11, 2007. On August 16, 2007, and on October 29, 2007, applicants filed supplemental responses to the non-final Office action. There is no evidence that the examiner requested that the supplemental amendments be filed. Pursuant to 37 CFR 1.704(c)(8), it is appropriate to enter a reduction to the patent term adjustment of 291 days beginning from the day after the date the initial reply was filed, September 8, 2006, and ending on the date the second supplemental reply was filed October 29, 2007⁴. Accordingly, the period of reduction to the patent term adjustment of 291 days for applicant delay pursuant to 37 CFR 1.704(c)(8) will not be removed.

³ It is noted that filing of the supplemental amendment filed June 8, 2006, is also subject to a reduction under 37 CFR 1.704(c)(8), from the period beginning January 18, 2006, through June 8, 2006. However, since the period overlaps with the period of reduction for the supplemental amendment filed June 12, 2006, which is January 18, 2006, through June 12, 2006, only the greater period of reduction 146 days was entered.

⁴ It is noted that filing of the supplemental amendment filed August 16, 2007, is also subject to a reduction under 37 CFR 1.704(c)(8), from the period beginning January 12, 2007, through August 16, 2007. However, since the period overlaps with the period of reduction for the supplemental amendment filed October 29, 2007, which is January 12, 2007, through August 16, 2007, only the greater period of reduction 291 days was entered.

Further review of the application file record revealed that the adjustment to the patent term of 21 days pursuant to 37 CFR 1.702(a)(2)⁵ is not warranted. A non-final Office action was mailed on December 24, 2008, to which applicant responded by filing a Notice of Appeal and appeal brief on February 4, 2009. By a communication mailed March 16, 2009, applicants were informed that the appeal brief filed February 4, 2009, was not compliant with 37 CFR 41.37. Accordingly, the appeal brief filed February 4, 2009, was not properly taken under 35 U.S.C. 134, and, therefore, would not have started the Office's period for response pursuant to 37 CFR 1.702(a)(2). Rather, the Office's period for response pursuant to 37 CFR 1.702(a)(2) is calculated from the appeal brief filed on March 18, 2009. The Office responded, within four months pursuant to 37 CFR 1.702(a)(2), to the appeal taken under 35 U.S.C. 134 filed March 18, 2009, by mailing a Notice of Allowance on June 25, 2009. Accordingly, the period of adjustment to the patent term of 21 days is unwarranted and is being removed.

In view thereof, the correct patent term adjustment at the time of the mailing of the Notice of Allowance is **two hundred and nine (209) days** (775 days of Office delay - 566 days of applicant delay).

Applicants are reminded that any delays by the Office pursuant to 37 CFR §§ 1.702(a)(4) and 1.702(b) and any applicant delays under 37 CFR § 1.704(c)(10) will be calculated at the time of the issuance of the patent and applicants will be notified in the Issue Notification letter that is mailed to applicants approximately three weeks prior to issuance.

Deposit account 07-2380 will be charged \$200.00 for the fee required under 37 CFR 1.18(e). No additional fees are due.

⁵ Pursuant to 37 CFR 1.702(a)(2),

(a) Subject to the provisions of 35 U.S.C. 154(b) and this subpart, term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to:

(2) Respond to a reply under 35 U.S.C. 132 or to an appeal taken under 35 U.S.C. 134 not later than four months after the date on which the reply was filed or the appeal was taken.

The Office of Data Management has been advised of this decision. This matter is being referred to the Office of Data Management for issuance of the patent.

Telephone inquiries regarding this matter should be directed to Kenya A. McLaughlin, Petitions Attorney, at (571) 272-3222.



Anthony Knight
Director
Office of Petitions

Enclosure: Copy of updated PAIR screen

Day : Saturday
Date: 4/24/2010

PALM INTRANET

Time: 08:22:44

PTA Calculations for Application: 10/033862

Application Filing Date:	12/20/2001	PTO Delay (PTO):	787
Issue Date of Patent:		Three Years:	0
Pre-Issue Petitions:	0	Applicant Delay (APPL):	747
Post-Issue Petitions:	0	Total PTA (days):	209
PTO Delay Adjustment:	169		

File Contents History

Number	Date	Contents Description	PTO	APPL	START
123	04/24/2010	ADJUSTMENT OF PTA CALCULATION BY PTO	169		
110	06/25/2009	MAIL NOTICE OF ALLOWANCE	21		93
109	06/22/2009	EXAMINER'S AMENDMENT COMMUNICATION			
108	06/22/2009	ISSUE REVISION COMPLETED			
107	06/22/2009	DOCUMENT VERIFICATION			
106	06/22/2009	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			
105	06/22/2009	NOTICE OF ALLOWABILITY			
100	04/24/2009	NOTICE OF APPEAL FILED			
99	04/13/2009	APPEAL BRIEF REVIEW COMPLETE			
98	04/13/2009	DATE FORWARDED TO EXAMINER			
97	03/18/2009	APPEAL BRIEF FILED			
96	03/16/2009	NOTICE -- DEFECTIVE APPEAL BRIEF			
95	03/12/2009	APPEAL BRIEF REVIEW COMPLETE			
94	03/12/2009	DATE FORWARDED TO EXAMINER			
93.1	02/04/2009	DEFECTIVE / INCOMPLETE APPEAL BRIEF FILED			
93	02/04/2009	APPEAL BRIEF FILED			
92	02/04/2009	NOTICE OF APPEAL FILED			
91	12/24/2008	MAIL NON-FINAL REJECTION			
90	12/22/2008	NON-FINAL REJECTION			
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88	10/17/2008	DATE FORWARDED TO EXAMINER			
87	09/30/2008	APPEAL BRIEF FILED			
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74	11/30/2007	REFERENCE CAPTURE ON IDS				
73	11/30/2007	ELECTRONIC INFORMATION DISCLOSURE STATEMENT				
72	11/30/2007	INFORMATION DISCLOSURE STATEMENT (IDS) FILED				
71	11/28/2007	PETITION ENTERED				
70	11/07/2007	DATE FORWARDED TO EXAMINER				
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67	08/19/2007	DATE FORWARDED TO EXAMINER				
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64	06/29/2007	WITHDRAWAL OF NOTICE OF ALLOWANCE				
63	06/15/2007	EXAMINER'S AMENDMENT COMMUNICATION				
62	03/16/2007	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)				
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60	01/11/2007	OATH OR DECLARATION FILED (INCLUDING SUPPLEMENTAL)				
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58	01/31/2007	DATE FORWARDED TO EXAMINER				
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53	11/02/2006	CASE DOCKETED TO EXAMINER IN GAU				
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41	01/17/2006	INFORMATION DISCLOSURE STATEMENT (IDS) FILED			
40	01/23/2006	DATE FORWARDED TO EXAMINER			
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37	01/09/2006	IFW TSS PROCESSING BY TECH CENTER COMPLETE			
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29	03/28/2005	EXAMINER INTERVIEW SUMMARY RECORD (PTOL - 413)			
28	10/21/2004	DATE FORWARDED TO EXAMINER			
27	10/15/2004	RESPONSE AFTER NON-FINAL ACTION			
26	10/15/2004	WORKFLOW INCOMING AMENDMENT IFW			
25	07/16/2004	MAIL NON-FINAL REJECTION			
24	07/12/2004	NON-FINAL REJECTION			
23	05/10/2004	DATE FORWARDED TO EXAMINER			
22	04/29/2004	RESPONSE AFTER NON-FINAL ACTION			
21	03/22/2002	REFERENCE CAPTURE ON IDS			
20	04/29/2004	WORKFLOW INCOMING AMENDMENT IFW			

19	02/25/2004	MAIL NON-FINAL REJECTION			
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17	12/09/2003	IFW AMENDED CASE PROCESSING COMPLETE			
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15	11/12/2003	RESPONSE TO ELECTION / RESTRICTION FILED			
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12	09/11/2003	REQUIREMENT FOR RESTRICTION / ELECTION			
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EXPLANATION OF PTA CALCULATION

EXPLANATION OF PTE CALCULATION

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